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| 09/651,362 | 08/28/2000 | Hiroshi Endo | SAT 152 | 9895 |

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EXAMINER

SAM, PHIRIN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2661

DATE MAILED: 08/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/651,362

Applicant(s)

ENDO, HIROSHI

Examiner

Phirin Sam

Art Unit

2661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-19 is/are rejected.
- 7) ☒ Claim(s) 2-4 and 20-22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to because figures 4, 5, 12, and 13 do not provide the label for each block and one of ordinary in the art will not understand what are these blocks represented? Therefore, corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities:

Regarding MCF, EOP, NSF, DCN, and NSS, these abbreviations need to be provided full words along with the abbreviations. For example, message confirmation (MCF) or non-standard facilities set-up (NSS). Therefore, the appropriate corrections are required.

Claim Objections

3. Claims 7, 8, and 12-22 are objected to because of the following informalities:

Regarding claims 7, 8, and 12, DCS, CFR, TCF, MCF, EOP, DCN should be provided in full words along with the abbreviations. For example, message confirmation (MCF). Therefore, the appropriate corrections are required.

Claims 13-22 are objected to under informalities because they depend on the rejected claim 12.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1 and 5-19 are rejected under 35 U.S.C. 102(e) as being anticipated by over Nicol (U.S. Patent 6,757,367)

Nicol discloses the invention (**claims 1 and 6**) as claimed including a facsimile communication system comprising:

- (a) a facsimile device on a sender side (see Figs. 1 and 9, elements 14a and 134a, col. 4, lines 39-42, col. 20, lines 51-54).
- (b) a gateway device on a sender side connectable through a telephone line to the facsimile device (see Figs. 1 and 9, elements 12a and 132a, col. 4, lines 36-42, col. 20, lines 51-54).
- (c) a gateway device on a receiver side connectable to the gateway device on the sender side through a communication line to which a protocol being different from that applied to the telephone line is applied (see Figs. 1 and 9, elements 12b, 132b, and 132c, col. 4, lines 36-51, and col. 20, lines 55-62).
- (d) a facsimile device on a receiver side connectable to the gateway device on the receiver side through the telephone line to which the same protocol as applied to the telephone line is applied (see Figs. 1 and 9, elements 14b, 134b, and 134c, col. 4, lines 39-51).
- (e) whereby the gateway device on the receiver side is provided with memory, to store data transferred from the gateway device on the sender side (see Fig. 2, element 18, col. 4, line 54), used when the data is transmitted from the facsimile device on the sender side through both the gateway devices to the facsimile device on the receiver side (see Fig. 1, col. 4, lines 39-51) a monitoring circuit to monitor accumulated amounts of the data to be stored in the memory (see Figs. 3 and 13, elements 24, 208, and 216, col. 5, lines 14-18, 57-60, and col. 28, lines 39-49) and an accumulated data amount calculating circuit operated to store, in the memory, amounts of data required to prevent communication failures between the gateway device on the receiver side and the facsimile device on the receiver side even when delays in communications develop prior

to the start of transmission of the data from the gateway device on the receiver side to the facsimile device on the receiver side and operated to calculate the required amounts of data (see Fig. 13, elements 208 and 216, col. 28, lines 30-49), and the gateway device on the receiver side is operated to start the transmission of the data to the facsimile device on the receiver side when the accumulated amount data calculating circuit exceeds the required amounts of data (see Figs. 12 and 13, col. 28, lines 30-67).

Regarding claims 7 and 9-11, Nicol discloses the gateway device on the receiver side, when receiving a DCS signal showing a communication mode from the facsimile device on the sender side through the gateway device on the sender side, transfers the DCS signal to the facsimile device on the receiver side and before receiving a CFR signal showing a confirmation of the completion of receiving preparation from the facsimile device on the receiver side which has responded to the DCS signal, return another CFR signal used to receive the data from the facsimile device on the sender side through the gateway device on the sender side to the facsimile device on the sender side (see Figs. 9 and 11, col. 23, lines 42-67, and col. 24, lines 1-40).

Regarding claims 5, 8, and 12-19, Nicol discloses the gateway device on the receiver side, when receiving the DCS signal showing the communication mode from the facsimile device on the sender side through the gateway device on the sender side, transfers the DCS signal to the facsimile device on the receiver side and then sends a TCF signal used to check a receiving capability of the facsimile device on the receiver side to the facsimile device on the receiver side and, after completion of the transmission of the TCF signal, sends a new TCF signal to the facsimile device on the receiver side before the time elapsed after the facsimile

device on the receiver side has completed a preparation for receiving data exceeds the predetermined threshold time being shorter than a threshold time for a communication breakdown set to communications between the gateway device on the receiver side and the facsimile device on the receiver side, in order to prevent the breakdown of communications between the gateway device on the receiver side and the facsimile device on the receiver side during the accumulation of the required amounts of data (see Figs. 9 and 11, col. 23, lines 42-67, and col. 24, lines 1-62, and col. 25, lines 4-37).

Allowable Subject Matter

6. Claims 20-22 would be allowable if rewritten to overcome the objection under informalities, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(1) Rabenko et al (U.S. Patent 6,765,931) discloses gateway with voice.

(2) Schuster et al (U.S. Patent 6,483,600) discloses system and method for communicating real-time facsimiles over data networks.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Phirin Sam whose telephone number is (703) 308 - 9294. The Examiner can normally be reached on Monday - Friday from 8:30AM - 4:00PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Douglas W. Olms can be reached at (703) 305 - 4703. The fax number for the organization where this application or proceeding is assigned is (703) 872 - 9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217 - 9197 (toll-free).

Respectfully submitted,

Date: July 24, 2004

A handwritten signature in black ink, appearing to read 'Phirin Sam', written over a horizontal line.

Phirin Sam
Patent Primary Examiner